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In re Application of

Date: November 12, 2003

Yevgeniy Eugene Shteyn

Examiner: Michael L. Lindinger

Serial No.: 09/900,375

Art Unit: 2841

Confirmation No.: 4295

Filed: July 5, 2001

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Atty Docket No.: US018098

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Attn: Examiner Michael L. LindingerBRIEF BEFORE THE BOARD OF APPEALS

This is an appeal from a Final Rejection dated June 11, 2003. A Notice of
Appeal was received by the Patent Office September 11, 2003.

REAL PARTY IN INTEREST

The real party in interest is Phillips Electronics North America Corporation.

RELATED APPEALS AND INTERFERENCES

None.

Page 1 of 14 BRIEF BEFORE THE BOARD OF APPEALS
Serial No. 09/900,375

STATUS OF CLAIMS

Claims 1-13 remain in the application and are presented in attached Appendix A.

No claims are allowed.

Claims 1, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable by Hepp et al. ("Hepp") (US Pat. No. 6,449,219).

Claims 2-4, 6-7, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hepp in view of Nixon (US Pat. No. 6,033,316).

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hepp in view of Narayanaswami (US Pat. No. 6,477,117).

STATUS OF AMENDMENTS

Amendments to claims 1, 3, 12, and 13 were made in Applicant's Response to the Office Action Dated February 13, 2003. Amendments to claims 1, 12, and 13 were made in Applicants Response to Office Action Dated November 25, 2002. (The claims in the Appendix contain the amendments.)

The rejections of the claims, for reasons explained below, are clearly erroneous.

SUMMARY OF INVENTION

The present invention addresses problems inherent in conventional scheduling systems. Conventional scheduling and calendaring systems (paper and PC based) are typically presented in tabular formats with activities scheduled in lines, boxes, or columns. For users, there is not immediate recognition or association of activities with times or dates, as the user must read and interpret the layout and associated scheduling information. The present invention recognizes a need for simpler and quicker recognition and association of activities and times. The inventor appreciated unforeseen advantages in traditional dial faces for timepieces, which were considered by many as outmoded in favor of digital displays, and arrived at the claimed association of time-of-day segments and graphical representations for scheduled activities.

ISSUES

1. Whether claims 1, 5, and 8 would have been unpatentable under 35 USC § 103(a) over Hepp (U.S. Patent 6,449,219).
2. Whether claims 2-4, 6-7, and 12-13 would have been unpatentable under 35 U.S.C. 103(a) over Hepp in view of Nixon (US Pat. No. 6,033,316).

3. Whether claims 9-11 would have been unpatentable under 35 U.S.C. 103(a) over Hepp in view of Narayanaswami (US Pat. No. 6,477,117).

GROUPING OF CLAIMS

For the purpose and convenience of this appeal, and without admitting that grouped claims are not independently patentably distinct, Applicant groups the claims as follows:

Claims 1, 5, and 8 stand as a group.

Claims 2-4, 6-7, and 12-13 stand as a group.

Claims 9-11 stand as a group.

ARGUMENT

Three basic criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, not in applicant's disclosure. *Id.*

Hepp, the primary reference for the rejection of all claims, is generally directed to a "dial of a timepiece, where an animation of the dial is coupled with the seasonable progress of the time." (Col. 6, lines 12-15; claim 1.) As explained below, Hepp either alone or in combination with other references, does not disclose the claimed invention. Claim 1 is representative of the independent claims for purposes of distinguishing over Hepp:

1. An electronic device with a timepiece having a dial face that comprises a display monitor for providing a graphical representation of a scheduled activity associated with a time-of-day segment displayed on the dial face.

The Cited Prior Art Does Not Disclose A Dial Face That Displays A Graphical Representation

In the final Office Action dated June 11, 2003, the Examiner considered character 15 in Hepp as corresponding to a graphical representation of a scheduled activity because it "can take on several tasks, e.g., to remind of jobs to be done or to present the illustrated information or to elaborate on it." (Col. 5, lines 25-31.) The Examiner has not identified any other feature in Hepp as a representation of a scheduled activity.

The plain language of the claims calls for the *dial face* to display the graphical representation of the scheduled activity. Assuming for now that character 15 is

a scheduled activity—and below it is demonstrated that it is not—Hepp does not teach or suggest that the dial face ever displays character 15. On the contrary, Fig. 1 in Hepp and the associated text show that character 15 is spatially separated from the dial face, as explained below in further detail.

The Cited Prior Art Does Not Disclose The Claimed "Segments"

In addition to not showing the graphical representation on the dial face, Hepp does not teach or suggest any association of a scheduled activity with *time-of-day segments* on or about the dial face so that a user can quickly visually perceive from the dial face what activities are scheduled for particular times of the day.

A time-of-day segment is to be interpreted according to the ordinary meaning of "segment", which, in pertinent part, is defined as:

1. a. A part of a plane (or solid) figure separated off by an intersecting straight line (or plane); esp. (more fully segment of a circle) a plane figure contained by a chord and an arc of a circle. Also loosely, an arc of a circle, a sector of a circle. L16. b. A portion of anything resembling a segment of a circle or sphere. M17. 2. A piece cut or broken off unevenly, a fragment, rare. L16.

The New Shorter Oxford English Dictionary, 1993 (Exhibit A)

Nothing in Hepp meets this definition. Character 15 and all other animations shown in Hepp stand apart from the Hepp dial face and are not associated with time-of-day segments. In contrast, the present invention illustrates time-of-day segments 110, 112, 114, 116 for scheduled activities, which are provided by the

dial face. (See Fig.1 and specification page 4, for example.) These are segments within the ordinary sense of the word because they are arcs indicating time slots based on the full circle of the dial face (See specification, p. 4, for example.) It is clearly erroneous for character 15 or any other feature in Hepp to be interpreted as associated with a time-of-day segment under the ordinary meaning of "segment".

Further, the Examiner characterizes the claims as reciting a "scheduled activity 15 *relative to* a time of day display". (Office Action dated 6/11/03, p. 2.) The Examiner considers reference hands 4 or display 14 in Hepp to be a time-of-day display. However, the claims do not use the wording "relative to"; instead they use the wording "*associated with*". This is perhaps a subtle but significant point. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In the present case, the Examiner has not given patentable weight to "associated with". The verb "associate" means to combine or join together. (Exhibit A.) The word "relative" suggests a less definite relationship. (See Exhibit A.) The rejections therefore are clearly erroneous because the Examiner has failed to identify in the prior art the claimed association.

The Proposed Modifications Of Hepp Are Impermissible And Undesirable

All claims were rejected based on Hepp as modified with alleged common knowledge of rearranging parts per *In re Jap/ske* 181 F.2d 1019, 86 USPQ 70

(CCPA 1950) and in view of Nixon (claims 2, 4, 6-7, 12-13) or in view of Narayanaswami (claims 9-11).

In addition to missing elements and arrangement of elements, and to the lack of weight given to the specific language used in the claims, the rejections are clearly erroneous because they are based on proposed modifications of Hepp using supposed common knowledge of rearranging parts that is improper under the governing legal principles.

The Examiner acknowledges that Hepp "does not explicitly teach a time of display [sic] segment located on the dial face." (Office Action dated 6/11/03, p.2.) However, the Examiner asserts, relying on *In re Japiske* 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) that "[i]t would have been obvious to . . . to adapt the dial face of the Hepp reference to change the location of the graphical representation of the scheduled activity with a time-of-day segment from the outside of the dial face to the dial face itself since it has been held that rearranging the parts of the invention involves only routine skill in the art." (Office Action dated 6/11/03, p.3) The Examiner also states that changing one animated representation for another is an obvious step in the art, but it is unclear from the Office Action, p.3, what the Examiner specifically has in mind in making this statement. For example, as noted above, the Examiner acknowledges that nothing in Hepp equates to a "time-of-day segment," and the Examiner has not identified anything but character 15 as a graphical representation of scheduled activity. So it is unclear how the Examiner would arrive at the claimed arrangement of a graphical

representation and time-of-day segment by merely substituting one animation in Hepp for another.

Significantly, the Examiner's reliance on *In re Japiske* is misplaced. *In re Japiske* has been rejected or not applied in every¹ instance it has been cited to stand for the principle that rearranging parts is within the common knowledge of those skilled in the art. The case, without more, cannot support the rejection. For example, in *In re Chatillion, et al.*, 2001 WL 1339886 (Bd.Pat.App & Interf.), the Board stated:

In further support of this rejection, the examiner has relied on *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), urging that this case sets forth that as a general proposition "it has generally been recognized that the rearrangement of location of parts involves only routine skill in the art". . . .

In this regard, it is clear that the examiner has fallen victim to what our reviewing Court has called 'the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher.' *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

With regard to the examiner's use of a per se rule such as that derived from *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), we direct the examiner's attention to *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) wherein the Court of Appeals for the Federal Circuit has held that the claimed invention as a whole must be evaluated under the standards set down in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), and its progeny, and that the use of per se rules is improper in applying the test for obviousness under 35 U.S.C. § 103 since such rules are inconsistent with the fact-specific analysis of claims and prior

¹ Only once—and that was 50 years ago—has it been given any weight in supporting an argument of obviousness and that was for a different point of law. See *Dalin v. Watson*, 204 F.2d 730, 92 U.S.App.D.C. 270.

art mandated by section 103. Moreover, we also find that we are in agreement with appellants' treatment in the reply brief of the examiner's reliance on the Japikse case.

See also In re Kobayashi et al., 2001 WL 1057541 (Bd.Pat.App & Interf.) ("The examiner relies upon *In re Japikse* As stated by the Federal Circuit.... 'reliance on per se rules of obviousness is legally incorrect and must cease'"); *In re Yamamoto, et al.*, 2002 WL 31234526 (Bd.Pat.App & Interf.) ("*Japikse*, to the extent it is good law, is inapplicable to the present rejection . . . The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."); *In re Robles, et al.*, 1997 WL 1883840 (Bd.Pat.App. & Interf.); *In re Brueggemann*, 2002 WL 32102466 (Bd.Pat.App & Interf.); *In re Allen, et al.*, 1999 WL 33226488 (Bd.Pat.App & Interf.); *In re McCrane*, 1998 WL 1736165 (Bd.Pat.App & Interf.); *In re Ziegler, et al.*, 1996 WL 33103147 (Bd.Pat.App & Interf.); *In re Nakano*, 2002 WL 31321757 (Bd.Pat.App & Interf.); *In re Paul, et al.*, 2002 WL 226977 (Bd.Pat.App & Interf.); *In re Fort*, 1997 WL 1884308 (Bd.Pat.App & Interf.); *In re Mangiagli*, WL 1990485 (Bd.Pat.App & Interf.); and *In re Afeyan, et al.*, WL 519771 (Bd.Pat.App & Interf.)

In view of foregoing cases, the Examiner was required to show some teaching or suggestion or motivation in the cited references themselves, as Applicant requested the Examiner to do pursuant to MPEP § 2144.03 and the cases cited

therein. (See Applicant's Response To Office Action Dated July 23, 2003, pp 8-9). However, no such teaching or suggestion was identified or is to be found.

As for motivation for the combination or knowledge, the mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner's proposed modification of associating character 15, or any other graphical representation of Hepp, with the dial face would in fact be problematic and undesirable. While Hepp discloses a dial face 3, there is no teaching or suggestion that the supposed scheduled activity—character 15—is or can be associated with any segment of the face. This is because Hepp teaches that character 15 has a particular form and function that would be inconsistent with the proposed modification.

Detailed information about character 15 is found in column 8 of Hepp where we learn that character 15 is "Joe", a "comic character". Joe is optional and may give weather forecasts, bet with users about the weather, provide animated entertainment, and escort users through different pages of the device, etc. Hepp specifically teaches the advantages of displaying Joe outside the dial face, close to tree trunk 9. (See Col. 8, lines 1-20.) It would be inconsistent with the foregoing teachings of Joe's contemplated animated functions to provide for the dial face to display Joe in his contemplated form or in a substitute form

representing a time-of-day segment. As examples, the animations of the character and dial face could obscure or crowd each other, interfering with the functions of each; the comic aspect of Joe would be lost; an association with the dial face would not be suitable for the multitask role of the character, such as which contemplates Joe being displayed apart from the dial face; etc. In short, the multitask role contemplated for character 15 would be hindered if it were associated with a segment on the dial face.

The Prior Art Does Not Disclose A Scheduled Activity, As Claimed

Hepp does not disclose that character 15 is used to represent scheduled activities. The term "scheduled" and the disclosure of the present invention contemplate that a scheduled activity is something entered by or otherwise under the control of the user. In contrast, Hepp only contemplates that character 15 may be used "to remind of jobs to be done." (Col. 5, lines 25-31.) However, a reminder is not necessarily a "scheduled activity". Hepp does not teach that a user has any control over the reminders represented by Joe. Hepp does not indicate what is meant by reminder. One would understand from Joe's appearance with gardening implements that this is a reminder of, for example, Spring and the season of gardening. This kind of reminder is not controlled by the user and therefore cannot be considered a "scheduled activity" in the context of the claims.

In an Advisory Action dated August 25, 2003, the Examiner commented that Hepp et al provides a time-of-day animation in the nature of a moon to sun animation that reads on the present invention. However, the Examiner did not correspond the sun and moon animations to any elements recited in the claims. In any case, the sun and moon animation would not support any rejection of the claims for the same reasons as noted above—there is no teaching that (1) the animations represent scheduled activities; the animations are in the form of segments or associated with the time-of-day display, and/or the animations are provided by the time-of-day display.

The Rejection of Claims 2-4, 6-7, and 12-13 as Obvious Based on Hepp in View of Nixon is Clearly Erroneous

Claims 2-4 and 6-7 depend directly or indirectly from claim 1. Applicant relies on the remarks made above as eliminating Hepp as the primary reference used to reject these claims and claims 12-13. Therefore, the rejections are clearly erroneous for the same reasons. Further, there is no teaching, suggestion, or motivation for the combination of Nixon with Hepp. Deficiencies in Nixon are detailed in Applicant's response to the first Office Action, which are incorporated herein by reference. In particular, Nixon is a rate of progress indication; it does not have disclosure for scheduling of activities; and the Examiner has not identified why the combination would be desirable.

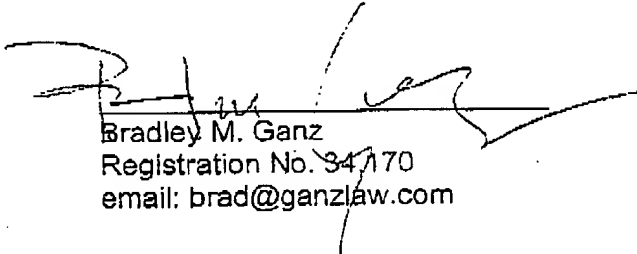
The Rejection of Claims 9-11 as Obvious Based on Hepp in View of Narayanswami is Clearly Erroneous

Claims 9-11 depend directly or indirectly from claim 1. Applicant relies on the remarks made above as eliminating Hepp as the primary reference used to reject these claims. Therefore the rejection is traversed for the same reasons. Further, there is no teaching, suggestion, or motivation for the combination of Hepp and Narayanaswami. In particular, the Examiner has not identified why the combination would be desirable.

For one or more of the reasons set forth above, all claim rejections are clearly erroneous, and the Board is respectfully requested to reverse the Examiner's rejection of all claims 1-13 and to confirm patentability thereof.

Respectfully submitted,

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Bradley M. Ganz
Registration No. 34,170
email: brad@ganzlaw.com

Correspondence to:

Philips Electronics North America Corporation
Intellectual Property & Standards
1109 McKay Drive, Mail Stop SJ 41
San Jose, California 95131
Telephone: (408) 617-7700
Facsimile: (408) 617-4856
USPTO Customer Number: 24738

Appendix A

1. An electronic device with a timepiece having a dial face that comprises a display monitor for providing a graphical representation of a scheduled activity associated with a time of day segment displayed on the dial face.
2. The device of claim 1, wherein the representation comprising a segment whose length is associated with the duration of the activity.
3. The device of claim 2, wherein the segment has a graphical attribute associated with the scheduled activity, the device being capable of associating a different graphical attribute with a different scheduled activity.
4. The device of claim 2, wherein a location of the representation is representative of a begin time of the activity.
5. The device of claim 1, wherein the graphical representation is programmable.
6. The device of claim 2, wherein the segment is located along a perimeter of the dial face.
7. The device of claim 1, wherein the device is capable of providing at least a further graphical representation of a further scheduled activity.
8. The device of claim 1, comprising a communication component for communicating with another electronic device.
9. The device of claim 8, wherein the communication uses a short range communication protocol.
10. The device of claim 9, wherein the other electronic device comprises an electronic calendar.
11. The device of claim 9, wherein the other electronic device comprises a mobile phone.

12. A method of enabling an electronic device to be programmed, the device having a timepiece with a dial face that comprises a display monitor for providing a graphical representation of a scheduled activity associated with a time of day segment displayed on the dial face, the method comprising communicating data to the device for control of the representation.
13. A software application for rendering a dial face of a timepiece on a display monitor, the application being capable of rendering a graphical representation of a scheduled activity on the dial face, a location of the representation on the dial face corresponding to a time slot for a time of day associated with the scheduled activity.